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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,965	09/15/2000	GETHER IRICK JR.	05015.0365U1	3021

23859 7590 11/21/2002

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[REDACTED] EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
1712	78

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/662,965	Applicant(s) Irick et al.
	Examiner Short	Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Priod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- Responsive to communication(s) filed on October 4, 2002
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1-5, 7-18, 20-22, 24-28 is/are pending in the application.
- Of the above claim(s) 8, 12, 13, 16, 20 is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1-5, 7, 9-11, 14, 15, 17, 18, 21, 22, 24-28 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement

Application Papers

- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All Some* None of the:
- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 11 Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

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This action is in response to the request for continued examination (RCE) and preliminary amendment filed on October 4, 2002.

Claims 8, 12, 13, 16 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9-11, 14, 15, 17, 18, 21, 22 and 24-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blumenthal. The reference was discussed in the Office actions mailed November 30, 2001 and June 18, 2002.

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Additionally, use of the biodegradable polyester/terpene-phenol resin compositions in articles comprising containers and film is taught at col. 9, lines 30-60. Use of biodegradable polyester/terpene-phenol resin compositions in a method comprising forming the compositions into an article comprising film or container is anticipated by or would have been obvious over the teachings of Blumenthal.

Claims 1-5, 9-11, 14, 15, 17, 18, 21, 22 and 25-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Schoenberg, Rutherford, Iovine and Kauffman. The references were discussed in the Office actions mailed November 30, 2001 and June 18, 2002. Additionally, use of the biodegradable polyester/terpene-phenol resin compositions in articles comprising containers and/or film is taught at col. 7, lines 37-53 (Schoenberg), col. 9, lines 29-49 (Rutherford), col. 5, lines 1-26 (Iovine) and col. 4, lines 44-65 (Kauffman). Use of biodegradable polyester/terpene-phenol resin compositions in a method comprising forming the compositions into an article comprising film or container is anticipated by or would have been obvious over the teachings of each of the references.

Claims 1-5, 9-11, 14, 15, 17, 18, 21, 22 and 25-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese '903. The reference teaches injection molded articles prepared from compositions comprising biodegradable polyester and terpene-phenol resin. See examples. The terpene-phenol resin inherently slows the rate of degradation of the polyester.

Claims 10, 11, 14, 15, 17, 18 and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hashitani. The reference teaches the use of phenol compounds to slow the degradation of biodegradable polyesters used to form injection molded articles. See col. 3, lines 52-56, col. 4, lines 29-44 and 63-64, col. 5, lines 10-28

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and col. 6, lines 33-38. Use of compositions comprising a biodegradable polyester and phenol compound to form injection molded articles is anticipated by or would have been obvious over the teachings of the reference in order to show the degradation rate of the biodegradable polyester and improve the durability of the injection molded article. As a choice of components is required, this rejection is made under 35 U.S.C. 102 and 103.

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PRIMARY EXAMINER

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November 14, 2002

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